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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,695	07/25/2003	Ronald Hubert Carlos Cornelissen	0142-0419P	2677
2292 7590 01/11/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER HU, HENRY S	
			ART UNIT 1713	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
31 DAYS	01/11/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 31 DAYS from 01/11/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

## Office Action Summary

Application No.

10/626,695

Applicant(s)

CORNELISSEN ET AL.

Examiner

Henry S. Hu

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Petition of October 20, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. It is noted that USPTO has received an **IDS** (1 page) filed on July 25, 2003. It is also noted that Applicants' **Petition** Letter filed on October 20, 2004 for **US filing date of July 25, 2003** was granted on October 2, 2006. **Claims 1-11** with two independent claims (**Claim 1 and Claim 11**) are now pending. An action follows.

### *Election/Restrictions*

2. Restriction to one of the following inventions is required under 35 U.S.C. 121. It is noted that both two independent claims are marked with an **underline**.

I. **Claims 1-7**, drawn to a cross-linkable compound comprising a perfluoro-polyether (PFPE) moiety which is ultimately terminated by an oxygen atom and bonded through a spacer attached to the said oxygen atom with an ethylenically unsaturated group, wherein the spacer extends over at least three atoms between the oxygen atom and the ethylenically unsaturated group.

II. **Claims 8 and 9**, drawn to a process of making the cross-linkable compound of Group I by reacting a hydroxyl-terminated PFPE compound with a compound of A-B-Hal as specified.

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III. **Claim 10**, drawn to **a perfluoropolyether rubber obtained by hydrosilating** the cross-linkable compound of Group I.

IV. **Claim 11**, drawn to **an apparatus for transferring a toner image from an image-forming medium to a receiving medium** comprising **three** components including: (A) **an endless movable intermediate medium** including a support provided with a top layer secured to the support via a rear surface, the intermediate medium being in contact with the image-forming medium in a first transfer zone; (B) **heating means** for heating the toner image on the top layer of the intermediate medium; a biasing means for contacting the intermediate medium in a second transfer zone; and (C) **transport means** for transporting the receiving medium through the second transfer zone, wherein the top layer comprises the perfluoropolyether rubber.

3. The inventions are distinct, each from the others because of the following reasons:

**Although each of four inventions may contain fundamentally the same PTFE-containing cross-linkable compound as starting material, they are actually related to four subject matters** due to the presence or absence of other process steps or additive components.

**Group I and Group II** is related to a product and its process of making. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed in Invention II can be applied to make other and materially different product or (2) that

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the product as claimed in Invention I can be made by another and materially different process (MPEP § 806.05(f)). Condensation of hydroxyl group with halogenated compound certainly can be replaced with other type reactions as known in the art so as to obtain the same product.

4. **Group III is drawn to a perfluoropolyether rubber obtained by hydrosilating the cross-linkable compound of Group I, while Group IV is drawn to a quite different subject matter such as an apparatus for transferring a toner image from an image-forming medium to a receiving medium.** In a close examination, the compound in Group I may be directly used as a regular organic compound rather than being crosslinked into said rubber of Group III.

Hydrosilylation used in Group III is a specific reaction in the art and will certainly involve the use of catalyst and hydrosilane. Finally, as known in the art the crosslinked product certainly carries quite different properties and performance. The property is unique and thereby not interchangeable. Therefore the scope of the claims, i.e., the metes and boundaries are distinct.

5. Because these inventions are distinct for the reasons given above and the search required for each group is not required for other groups have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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6. It is noted that one phone call was made to **Joseph A. Kolasch** (registration # 22,463; tel: 703 205-8000) on **December 12, 2006** to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Dr. Henry S. Hu** whose telephone number is **(571) 272-1103**. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The fax number for the organization where this application or proceeding is assigned is **(571) 273-8300** for all regular communications.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Henry S. Hu

Patent Examiner, Art Unit 1713, USPTO

January 5, 2007



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